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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,476	11/08/2001	Keisuke Tanaka	2091-0247P	5608
<div>7590 10/02/2008</div> <div>BIRCH, STEWART, KOLASCH & BIRCH, LLP</div> <div>P.O. Box 747</div> <div>Falls Church, VA 22040-0747</div>				
<div>EXAMINER</div> <div>MILLA, MARK R</div>				
<div>ART UNIT</div> <div>2625</div>		<div>PAPER NUMBER</div>		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/986,476

Applicant(s)

TANAKA, KEISUKE

Examiner

Mark R. Milia

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,7-9,11,14-16,18 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7-9,11,14-16,18 and 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-884)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 6/4/08 and has been entered and made of record. Currently, claims 1, 2, 4, 7-9, 11, 14-16, 18, and 20-31 are pending.

Response to Arguments

2. Applicant's arguments, see pages 11-22 or the remarks, filed 6/4/08, with respect to the rejection(s) of claim(s) 1, 8, 15, and 22 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 8-9, 11, 15-16, 18, 20, and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Document No. 11-203360 to Watanabe et al., as cited in the IDS dated 4/15/08. Reference will be made to a machine translation that is hereby attached.

Regarding claim 1, Watanabe discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data, the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see paragraphs 14, 16, and 51), and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see paragraphs 56-57), and displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see paragraphs 55-57), wherein the server is adapted to perform setting a predetermined storage period of the image data (see paragraphs 14 and 24-25), displaying the predetermined storage period on the user terminal (see Drawing 4 and paragraphs 62-63), extending the predetermined storage period for the image data for which the order was placed (see paragraphs 27-32, 38-40, 60, and 66), wherein the step of extending the predetermined storage period by the

server is initiated by the step of receiving the order for the print of the image data (see paragraphs 27-32, 38-40, 60, and 66).

Regarding claim 8, Watanabe discloses a print ordering system comprising a server adapted to receive an order for a print of image data (see paragraphs 14, 16, and 51) and a user terminal connected to the server via a network and used for placing the order for the print of the image data (see paragraphs 55-57), wherein the server is adapted to store the image data transferred thereto regardless of whether or not the order is placed at the time of transfer of the image data, and receives the order for the print regarding the image data stored therein after the image data are stored therein in the case where the order was not placed at the time of the transfer of the image data (see paragraphs 14, 16, and 51), and wherein the server is further adapted to display on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see paragraphs 55-57) to set a predetermined storage period of the image data, to display the predetermined storage period on the user terminal (see paragraphs 14 and 24-25), and to extend the predetermined storage period for the image data for which the order was placed (see paragraphs 27-32, 38-40, 60, and 66).

Regarding claim 15, Watanabe discloses a computer-readable recording medium storing a program to cause a computer to execute a print ordering method used in a print ordering system, the print ordering system comprising a server for receiving an order for a print of image data and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data, the program

comprising the procedures of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see paragraphs 14, 16, and 51) and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see paragraphs 56-57), and displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see paragraphs 55-57), the program causing the server to perform setting a predetermined storage period of the image data (see paragraphs 14 and 24-25), displaying the predetermined storage period on the user terminal (see Drawing 4 and paragraphs 62-63), and extending the predetermined storage period for the image data for which the order was placed (see paragraphs 27-32, 38-40, 60, and 66).

Regarding claims 2, 9, and 16, Watanabe further discloses accepting and storing image data the image data at the time the order is received if the order is placed at the time the image data are transferred (see paragraph 51).

Regarding claims 4, 11, and 18, Watanabe further discloses deleting the image data from the server after the predetermined storage period has elapsed since the image data were put into storage (see paragraph 65).

Regarding claim 23, Watanabe further discloses wherein the server is part of a print order reception center which also includes a database directory and a printer (see paragraph 55).

Regarding claims 24-26, Watanabe further discloses wherein the step of extending the predetermined storage period by the server is initiated by the step of receiving the order for the print of the image data (see paragraphs 27-32, 38-40, 60, and 66).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 20, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Souissi (US 6,556,817).

Regarding claim 22, Watanabe discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data, the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see paragraphs 14, 16, and 51), and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see paragraphs 56-57), writing a predetermined storage period of the image data in tag information of the image data (see paragraphs 14 and 24-25), and the server

performing extending the predetermined storage period of the image data for which the order was placed (see paragraphs 27-32, 38-40, 60, and 66).

Watanabe does not disclose expressly determining a time of day when communications costs are lower than at other times of day, performing transfer of the image data from the user terminal to the server during the time of day when communications costs are lower.

Souissi discloses determining a time of day when communications costs are lower than at other times of day and performing transfer of the image data from the user terminal to the server during the time of day when communications costs are lower (see column 5 lines 26-32 and column 6 lines 33-57).

Watanabe & Souissi are combinable because they are from the same field of endeavor, transmission of data over a network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the transferring of image data to a server when communications costs are low, as described by Souissi, and which is well known and commonly used, with the system of Watanabe.

The suggestion/motivation for doing so would have been to save money and be able to provide lost cost prints to a user by utilizing low cost communications and purging of image files after a certain period of time.

Therefore, it would have been obvious to combine Souissi with Watanabe to obtain the invention as specified in claim 22.

Regarding claim 20, Watanabe further discloses the procedure of displaying the predetermined storage period on the user terminal (see Drawing 4 and paragraphs 62-63).

Regarding claim 27, Watanabe further discloses wherein the step of extending the predetermined storage period by the server is initiated by the step of receiving the order for the print of the image data (see paragraphs 27-32, 38-40, 60, and 66).

7. Claims 7, 14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe as applied to claims 1, 8, and 15 above, and further in view of Chui (US 6,657,702).

Watanabe discloses setting the predetermined storage period of the image data (see paragraphs 14, 24-25, 27-32, 38-40, 60, and 66).

Watanabe does not disclose expressly if the order for the print of the image data is an order for a postcard which has seasonality.

Chui discloses if the order for the print of the image data is an order for a postcard which has seasonality (see column 4 lines 13-22 and column 23 lines 9-23).

Watanabe & Chui are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the order for a postcard, as described by Chui, with the system of Watanabe.

The suggestion/motivation for doing so would have been to provide a user/customer with more options for which to output desired images.

Therefore, it would have been obvious to combine Chui with Watanabe to obtain the invention as specified in claims 7, 14, and 21.

8. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe.

Watanabe discloses allowing a user to extend the predetermined storage period for the image data (see paragraphs 27-32, 38-40, 60, and 66).

Watanabe does not disclose expressly writing a message to be displayed on the user terminal containing information that the predetermined storage period has been extended by the server.

However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to display a message on the user terminal indicating that the storage period has been extended after the user performs actions to have the storage period extended as displaying messages confirming user action is well known and commonly used in the art, such as after a 'cancel' button is pressed and a message is displayed asking the user if they are sure they want to cancel the action.

9. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Souissi as applied to claim 22 above.

Watanabe discloses allowing a user to extend the predetermined storage period for the image data (see paragraphs 27-32, 38-40, 60, and 66).

Watanabe and Souissi do not disclose expressly writing a message to be displayed on the user terminal containing information that the predetermined storage period has been extended by the server.

However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to display a message on the user terminal indicating that the storage period has been extended after the user performs actions to have the storage period extended as displaying messages confirming user action is well known and commonly used in the art, such as after a 'cancel' button is pressed and a message is displayed asking the user if they are sure they want to cancel the action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571)272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached at (571) 272-7437. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia
Examiner
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